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In re application of  
Yaacov Almog et al.  
Serial No. 09/529,289  
Filed: April 7, 2000  
For: COATING SYSTEM FOR SUBSTRATES

DECISION ON  
PETITION

This is a response to the PETITION UNDER 37 C.F.R. 1.144 filed January 10, 2002 requesting that the examiner's finding of lack of unity of inventions between Group I, II, and III be vacated. The petitioner asserts that 37 CFR 1.475(b)(3) provides unity of invention in an application the contains claims directed to a product, method of manufacture and method of use. The petitioner asserts that the examiner improperly based the finding of lack of unity of inventions on 37 CFR 1.475(a), without considering 37 CFR 1.475(b).

**DECISION**

The instant application has been filed under 35 U.S.C. 371 as a national phase application of PCT/IL98/00491, and as such is subject to the unity of invention requirements set out in PCT Rules 13.1-13.4 and 37 CFR 1.475, as well as the PCT Administrative Instructions and Annex B. A review of the application record as well as 37 CFR 1.475, and the PCT Administrative Instructions and Annex B indicates that the petitioner's request cannot be granted.

The PCT Administrative Instructions, Annex B, Part 1 at (b) state that the "special technical features" common to all groupings of inventions shall be defined, as in PCT Rule 13.2, to mean,

**"those technical features which each of the claimed inventions, considered as a whole, makes over the prior art." (Emphasis added)**

A review of the reasons for advancing the requirement for restriction, at pages 3-9 of the Office action of June 14, 2001 and pages 2-4 of the Office action of October 10, 2001, reveals that the examiner did properly follow the direction given in PCT Rule 13.2 to consider the special technical feature as those features which each of the inventions, considered as a whole (together), makes over the prior art.

In the instant case, the claims of Groups I-III set forth a shared technical feature of a substrate comprising:

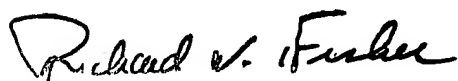
- a. a sheet of plastic,
- b. an underlayer coating comprising a first polymer material chosen from the group consisting of amine terminated polyamide, a silane coupling agent and amino propyl triethoxy silane, and
- c. an overlayer coating comprising a second polymer material having an outer surface which a toner image can be fused and fixed.

However, the shared technical feature of the specific substrate has been shown, on pages 5-8 of the Office action of October 10, 2001, to not make (be) a contribution over the prior art of Touhsaent ('960) alone or in combination with Ueno et al (US '268). Hence, the shared technical feature is not a "special" technical feature as required for unity of inventions under PCT Rule 13.2. Therefore the examiner's finding that there is a lack of unity of invention between Groups I-III was correct.

The petitioner's statement that 37 CFR 1.475 does not require a "special" technical feature, if the requirements of 37 CFR 1.475(b) are met is incorrect. As set forth in Annex B of the PCT Administrative Instructions, unity of inventions exists only when there is a technical relationship among the claimed inventions involving one of more of the same or corresponding special technical features (Emphasis added).

Upon mailing of this Decision, this application will be forwarded to the examiner for consideration of the Amendment and Response filed on January 10, 2002, which was in response to the October 10, 2001 Office action.

The Petition is **DENIED**.



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